

R E M A R K S

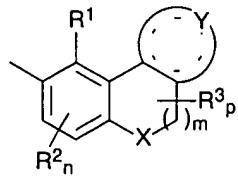
Claims 1, 5 to 16, 18 to 21 and 23 as set forth in Appendix I of this paper are now pending in this case. Claims 2 to 4 and 22 have been canceled and Claims 1, 5, 11 and 23 have been amended as indicated.

Applicants have limited the scope of Claims 1 to 16 and 23 to the elected group previously defined in Claim 22. The intermediate compounds defined in Claims 18 to 21 are restricted accordingly since the pertinent limitations are incorporated by reference to Claim 1. Additionally, applicants have corrected an error in Claim 5. No new matter has been added.

In light of the foregoing it is respectfully requested that the restriction requirement be withdrawn to the extent that it pertains to the scope of applicants' formula (I). Furthermore, the Examiner has not given any reasons why applicants' intermediate compounds which are defined in Claims 18 to 21 and applicants' compounds of formula (I) lack unity of invention. More particularly, the Examiner has not given any reasons why applicants' intermediate/product claims lack unity in light of the guidelines provided in the PCT Administrative Instructions, Annex B, Part 1, sections (g) and (h). Traversal of the Examiner's requirement to restrict between the product related claims and the intermediate related claims is therefore deemed appropriate. Favorable action is solicited.

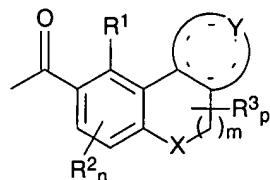
The Examiner has rejected Claims 1 to 6, 8, 12, 14 to 16, 22 and 23¹⁾ under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Tseng* (WO 97/19087). In this context the Examiner *inter alia* asserts that the formula representing *Tseng*'s compounds is generic to applicants' formula (I). Applicants respectfully disagree with this position.

The formula set forth on page 1, at indicated line 20, of *WO 97/19087*, while variable with regard to the moiety Q, mandates that the group J is a tricyclic system of formula



1) Now Claims 1, 5, 6, 8, 12, 14 to 16 and 23.

Accordingly, the compounds of **Tseng** are required to comprise a sub-structure:



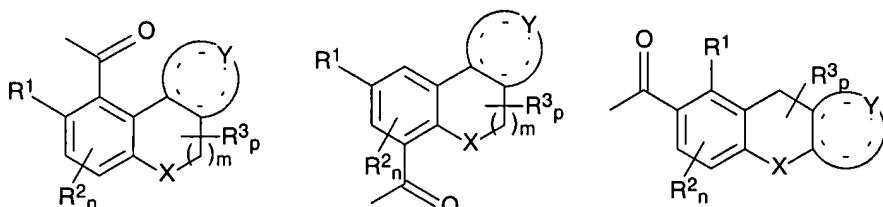
Variations within this substructure are according to the teaching of **Tseng** limited to variations within the definitions of R¹, R², R³, X, Y, n, m and p, and it is *inter alia* mandatory that the carbonyl group takes a position on the phenyl ring which

- a) is linked *ortho* to two phenyl carbon members which are not "bridged" by the other rings of the tricyclic system; and
- b) is linked *meta* and *para* to two phenyl carbon members which are "bridged" by the other rings of the tricyclic system.

It is further mandatory that the phenyl ring of the tricyclic system and the ring Y of the tricyclic system are linked

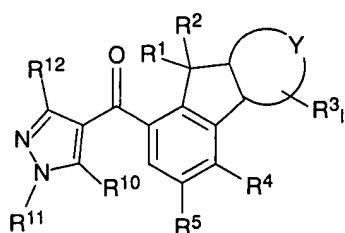
- i) by a direct bond, and
- ii) by a moiety -X-(CH₂)_m- wherein m denotes 0, 1, or 2 (optionally substituted by up to p groups R³);

and that the linkages (i) and (ii) originate from adjacent members of the phenyl ring and adjacent carbons of the ring Y. The foregoing mandatory substructure of **Tseng**'s compounds is, accordingly, not generic to moieties such as:



because, in the first two moieties, the requirements (a) and (b) are not met, and in the third of the moieties the requirement (i) is not met. Correspondingly, the compounds of **Tseng** are not generic to compounds which contain one of the foregoing moieties.

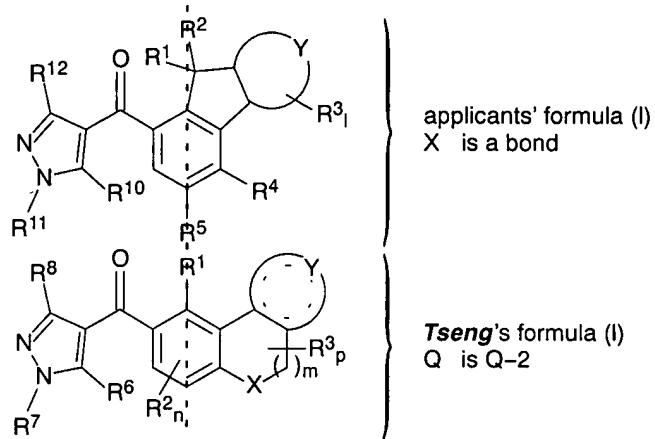
Applicants' compounds of formula (I) wherein, as now required in applicants' Claim 1, X denotes a bond, have the following structure:



Applicants' compounds of formula (I) are not a subgenus of the compounds disclosed by *Tseng* because the carbonyl group is in applicants' formula (I) not linked to the phenyl ring in a position

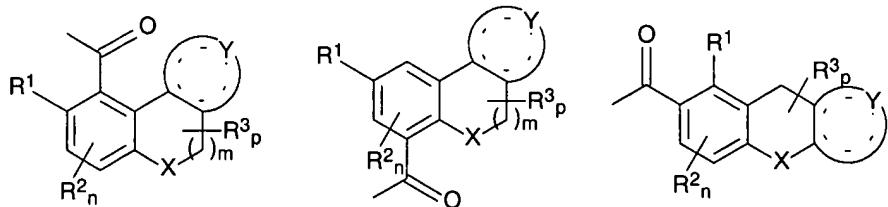
- a) which is *ortho* to two phenyl carbon members which are not "bridged" by the other rings of the tricyclic system; or
- b) which is *meta and para* to two phenyl carbon members which are "bridged" by the other rings of the tricyclic system.

The foregoing distinct structural differences between applicants' compounds and the compounds generically embraced by *Tseng*'s disclosure are further illustrated by the following representation:



Since applicants' compounds (I) fail to meet mandatory structural requirements of *Tseng*'s compounds, the Examiner's position that *Tseng*'s disclosure is generic to applicants' invention is not deemed to be well taken.

The Examiner further takes the position that the disclosure of *Tseng* provides for preferred compounds which are positional isomers of applicants' compounds. As explained in the foregoing, all of the compounds within the generic disclosure of *Tseng* are at least positionally isomeric to applicants' compounds and there is no overlap between applicants' structures and the generic disclosure of *Tseng*. Moreover, *Tseng*'s formula (I) allows for a variety of positional isomers, for example compounds which comprise one of the moieties:



The teaching of **Tseng** does not suggest or imply that any one of the various positional isomers of the disclosed compounds is useful. Accordingly, the teaching of **Tseng** cannot be considered to motivate a person of ordinary skill in the art to select one specific positional isomer from the various positional isomers which are possible.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. It is essential in this context that the teaching or suggestion to make the claimed combination as well as the reasonable expectation of success be found in the prior art²⁾. Correspondingly, it is impermissible in a determination of obviousness under Section 103(a) to base the teaching or suggestion to make the claimed combination and/or the reasonable expectation of success on the applicant's disclosure. The teaching of **Tseng** does not convey to a person of ordinary skill in the art that positional isomers of the disclosed compounds can reasonably be expected to exhibit useful properties. Moreover, the teaching of **Tseng** fails to direct the attention of a person of ordinary skill to one particular positional isomer. A person of ordinary skill in the art who selects the teaching of **Tseng** as a starting point for investigations into herbicidal compounds finds in **Tseng**'s disclosure, at best, an invitation to make each of the various positional isomers and to find out whether one of those isomers exhibits the desired effect³⁾. At best, the teaching of **Tseng** makes it obvious to a person of ordinary skill to try and find useful compounds within the multitude of variations that are possible. "Obvious to try" is, however, insufficient to render a claimed invention obvious within the meaning of Section 103(a)⁴⁾:

[i]nvention was merely "obvious to try" if the prior art gives either no indication of which parameters are critical or no direction as to which of the many possible choices is likely to be successful.

2) In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (CAFC 1991).

3) In doing so, a person of ordinary skill in the art would, of course, also have to permute **Tseng**'s groups, particularly Q, X and Y, within the definitions provided by the reference.

4) Merck & Co. Inc. v. Biocraft Laboratories Inc., (874 F.2d 804, 10 USPQ2d 1843 (CAFC 1989))

The Examiner's position that the teaching of *Tseng* renders the subject matter of applicants' claims *prima facie* obvious within the meaning of Section 103(a), is -in light of the foregoing- not deemed to be well taken. It is therefore respectfully requested that the rejection be withdrawn. Favorable action is solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. A check for the \$950.00 fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF



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Encl.: THE LISTING OF CLAIMS (Appendix I)

HBK/BAS